

P. ERIC PAVLIK et. al.  
Serial No.: 10/006,586

5

**REMARKS**

Claims 1-20 remain before the Examiner for reconsideration. Claims 1, 8 and 9 are currently amended.

In the Office Action dated September 23, 2004 claims 1-3, 6, 7 and 11-17 are rejected by the Examiner under 35 U.S.C. 102(6) "as being anticipated by U.S. Patent No. 5,925,022 to Battiato et al. (hereinafter "Battiato")". Specifically, the Examiner asserted that:

Battiato discloses a medical fluid injector having an injection head unit 22, stationary base unit (vertical portion of 34) attached to the surface of base portion 34, connecting member 35, bushing member /adapter (unnumbered, shown as hole on vertical portion of stationary base unit, in which connecting member fits) and coupler (unnumbered). See Figures 1-3.

Applicants respectfully traverse the Examiner's rejection.

To assert anticipation under Section 102(b) the cases hold that the Examiner:

must show that each element of the claim in issue is found, either expressly described or under principles on inherency, in a single prior art reference, or, that the claimed invention was previously known or embodied in a single prior art device or practice.

Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. Denied, 465 U.S. 1026 (1984); Tyler Refrigeration v. Kysor Industrial Corp., 777 F.2d 687, 689, 227 USPQ 845, 846-47 (Fed. Cir. 1984) (judgment of anticipation reversed). "In deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in the light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference." Lindemann, 730 F.2d at 1458, 221 USPQ at 485; Kalman, 713 F.2d at 771, 218 USPQ at 789.

"The test for determining if a reference anticipates a claim of a patent is whether the reference contains within its four corners adequate directions for the practice of the

P. ERIC PAVLIK et. al.  
Serial No.: 10/006,586

6

patent claim ... ." Kistler Instrument A.G. v. United States, 628 F.2d 1303, 1311, 203 USPQ 511, 519, aff'd., 211 USPQ 920 (Ct. Cl. 1980). The reference, whether foreign or domestic, patent or otherwise, must be construed strictly for what it "clearly and definitely discloses." Application of Boling, 292 F.2d 306, 310-11, 130 USPQ 161, 164 (CCPA 1961); Aluminum Co. of Am. v. Sperry Products, Inc., 285 F.2d 911, 922, 127 USPQ 394, 403 (6th Cir. 1960), cert. denied, 368 U.S. 890 (1961). A patent is not anticipated by a reference "unless the latter exhibits the invention in such full, clear and exact terms as to enable any person skilled in the art to practice it without making experiments." 285 F.2d at 922, 127 USPQ at 403.

Claim 1, as amended, specifies, *inter alia*, a "stationary" base unit adapted to be "attached" to a surface "other than a surface of the injector system". To the contrary, Battiato et al. discloses an injector head 22 attached to a vertical portion of a mobile base unit 34, which is (i) mobile and (ii) an integral part of the injector system of Battiato et al. The surface to which the stationary base unit of the present invention is adapted to be attached is within the environment of the room in which the injector system is located, but is not a part of or a component of the injector system itself. For example, the surface can be a surface of a room in which the injector system is located such as a support, wall or a ceiling of the room. That the stationary base unit of the present invention is attached to a surface other than a surface of the injector system itself is inherent in the nature of that base unit. The nature of the stationary base unit of the present invention and the significant differences between the stationary base unit of the present invention and a mobile base unit (such as disclosed in Battiato et al.) are discussed on page 6 of the specification as follows:

Although mobile base unit 270 provides substantial mobility to injection head unit 250 and enables placement thereof in the vicinity of the patient in many settings, lack of space in other settings can limit the mobility of both mobile base unit 270 and the medical personnel working around mobile base unit 270. Figures 2 through 4 illustrate an embodiment of the present invention in which connecting member 275 cooperates with a stationary base unit 400 to enable positioning of injection head unit 250 in the vicinity of a patient in, for example, MRI rooms of little space, without substantially obstructing the mobility of medical personnel. In one aspect,

P. ERIC PAVLIK et. al.  
Serial No.: 10/006,586

7

base unit 400 includes an attachment member or plate 410 that is attachable to, for example, a wall, a ceiling, a post or another surface (either generally flat or contoured) of a room via, for example, screws, adhesive or other attachment means or members.

One cannot obtain the benefits of the injector systems and methods of the present invention by simply attaching an injector head to a mobile base unit component of the injector system such as disclosed in Battiato et al.

Applicant respectfully asserts that, under the appropriate standard as set forth above, Battiato et al. does anticipate claims 1-3, 6, 7 and 11-17.

The Examiner also rejected claim 9 under 35 U.S.C. 103(a) "as being unpatentable over Battiato". Specifically, the Examiner asserted that:

Battiato shows the claimed invention as shown above but does not explicitly disclose the method steps described in claim 9. It would have been obvious to one of ordinary skill in the art to attach a base unit to a surface, remove the connecting member from the mobile floor stand and removably connecting the second end of a connecting member to the base unit in the invention of Battiato for such assembly/disassembly in order for the user to collapse the injector system.

Applicants respectfully traverse the Examiner's rejection.

Claim 9 specifies, *inter alia*, attaching a base unit to a surface other than a surface of the injector system, removing the connecting member from a mobile floor stand and connecting the connecting member to the base unit. Once again, the claim term "attaching" has significance because it means "to fasten on or affix to; connect or join." The American Heritage Dictionary, Second College Edition (1991). Applicant respectfully asserts that neither the vertical portion nor any other portion of the mobile base unit 34 in Battiato et al. is attached, fastened or affixed to fixed a surface other than a surface of the injector system. Moreover, there is no disclosure or suggestion to so attach the mobile base unit 34 of Battiato et al. to a surface other than a surface of the injector system.

P. ERIC PAVLIK et al.  
Serial No.: 10/006,586

8

Claims 4, 5, 8, 10, and 18-20 are rejected by the Examiner under 35 U.S.C. 103(a) "as being unpatentable over Battiato in view of U. S. Patent No. 5,494,036 to Uber, III et al. (hereinafter "Uber")". Specifically, the Examiner asserted that:

Battiato discloses the claimed invention including a portal 51, but does not show a remote power source and a non-rigid drive connection. Uber shows a connecting member that is generally cylindrical in which the non-rigid drive connection goes through (as indicated by connection line going into the connecting member) with the pressurizing member connected to a remote power source 18. See Figures 1 and 2. It would have been obvious to one of ordinary skill in the art to modify the invention of Battiato to have a non-rigid drive connection through the connecting member and the pressurizing member connected to a remote power source, as suggested by Uber, to provide portability and flexibility of the device without introducing extraneous electromagnetic radiation that could compromise image quality in MRI systems.

For the reasons set forth above, applicant respectfully traverses the Examiner's rejection.

Uber et al. does not overcome the deficiencies of Battiato et al. set forth above. Claim 8 specifies, *inter alia*, attaching a base unit to a surface other than a surface of the injector system. Like Battiato et al., Uber et al. discloses attachment of an injector head to only a wheeled, mobile base unit (see Figure 2 of Uber et al.) that forms a part of the injector system. Moreover, there is no disclosure or suggestion in either Battiato et al., Uber et al. or any combination thereof to modify the devices thereof to arrive at the present invention. See, for example, Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (P.O. Bd. Appl. 1984) ("The prior art must provide a motivation or reason for a worker in the art without the benefit of appellant's specification to make the necessary changes in the reference device."); Schenk v. Norton, 218 USPQ 698, 702 (Fed. Cir. 1983) ("Modification unwarranted by the disclosure of a reference is improper."); Ex Parte Acosta, 211 USPQ 636, 637 (P.O. Bd. Appls. 1980) (Examiner's combination of two references is improper where there is no basis in the record from which it can reasonably be inferred that one skilled in the art would have been led or motivated to modify the primary reference in the manner proposed by the Examiner.)

P. ERIC PAVLIK et. al.  
Serial No.: 10/006,586

9

In view of the above amendments and remarks, applicants respectfully requests that the Examiner withdraw the rejections of the claims, indicate their allowability and arrange for an official Notice of Allowance to be issued in due course.

Respectfully submitted,

P. ERIC PAVLIK et. al.

By

  
Henry E. Bartony, Jr., Esq.

Reg. No. 34,772

MEDRAD, INC.

One Medrad Drive

Indianola, PA 15051

(412) 767-2400 (phone)

(412) 767-8899 (fax)

Attorney for Applicants